

REMARKS

The Examiner has made three separate arguments: 1) certain dependent claims are allegedly improper, 2) Claims 49-69 are allegedly not enabled, and 3) double patenting. Each argument is addressed below.

1. The Claims Are Proper

The Examiner argues that the language of certain dependent claims is not consistent with the use of “in vitro” in the independent claims. In response, Applicants note that the distinction is really between cell-free and cellular systems - and that cellular systems can nonetheless be “in vitro.” Nonetheless, any alleged ambiguity can be solved by simply removing the term “in vitro” from the independent claims. Claims 52 and 63 make clear the distinction between cell-free and cellular systems.

It should be stressed that the Applicants have amended the pending claims to further clarify and define specific preferred embodiments of the invention. The amendments have not limited the claims and the right to pursue the original claims (or similar claims) is expressly reserved.

2. Claims 49-69 Are Enabled

The Examiner argues that the specification does not provide enablement for methods other than insertion of the markers by means of misaminoacylated tRNAs. This is simply not correct. The specification provides embodiments wherein markers are introduced through the use of primers which carry the coding sequences for particular markers. By way of illustration only, the Examiner is directed to Example 21, wherein three markers are introduced. Two of the markers (the myc epitope and the HisTag) are introduced through particular primers.

The Examiner’s argument seems to be based (improperly) on the word “incorporate.” The Examiner even goes so far as to say: “It is emphasized that the claims recite that the translation system acts to make the incorporation . . .” (Page 5). It is respectfully submitted that the claims say no such thing. The operational phrase in Claims 49 and 60 is that a “marker is introduced” into the protein during translation. Thus, while the translation system may be “capable of incorporating” (subpart a of Claims 49 and 60), it is sufficient that the markers are “introduced” into the resulting protein (subpart b of Claims 49 and 60) - whether by incorporation using tRNAs or by other methods described. The claims do not specify a mechanism - nor does patent law require such a thing. Importantly, the Examiner is not free to introduce the word “incorporate” into subpart b of Claim 49 and 60.

From an enablement standpoint, the specification is quite substantial. There are a number of different markers discussed and exemplified. There is no basis for concluding a lack of guidance.

3. Double Patenting

Without agreeing with the Examiner, but to further the prosecution, Applicants submit herewith a Terminal Disclaimer.

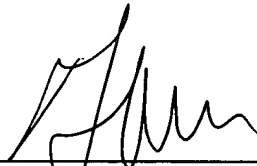
4. Information Disclosure Statement

A considerable number of references was provided in the IDS documents submitted in the parent case. The Examiner is requested to make these of record in this case. Of course, if the Examiner requires a separate set of copies, these can be provided.

CONCLUSION

The Applicant respectfully requests the Examiner enter the above indicated amendment. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicant encourages the Examiner to call the undersigned collect at 617.984.0616.

Dated: July 12, 2004



Peter G. Carroll
Registration No. 32,837

MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105